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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/833,202	04/11/2001	Jameel Menashi	01023	1699

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EXAMINER

ALEJANDRO, RAYMOND

ART UNIT	PAPER NUMBER
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1745

DATE MAILED: 06/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

09/833,202

Applicant(s)

MENASHI, JAMEEL

Examiner

Raymond Alejandro

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**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 13 June 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1,3-8,10 and 17-28.  
Claim(s) withdrawn from consideration: 2,9,11-13,15 and 16.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See next page.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
13. ☒ Other: IDS of 06/13/06 was not considered.

Raymond Alejandro  
Primary Examiner  
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## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed 06/13/06 have been fully considered but they are not persuasive.
2. With respect to applicant's arguments concerning all of the art rejections, applicant has stated that "*Applicant continues to disagree with the Examiner's position and the arguments provided in the previous response apply equally here*". In response, the examiner states that the examiner also continues to disagree with applicant's position and applicant's characterization of the cited references. Since applicant has essentially repeated the position taken in previous amendments, the examiner is also essentially maintaining the position taken in previous office action. The examiner's position is thus again set forth in detail infra for applicant's convenience (See items 7-10 below). In addition, new responses to applicant's arguments are also being presented immediately below to address other applicant's arguments.
3. (*new response*) Applicant now appears to conveniently characterize Yu et al's and Tosco et al' active layers by stating that such active layers are not the same as applicant's active layer because Yu et al and Tosco et al's active layers were subject to a specific pyrolysis treatment as shown in their respective EXAMPLES 14-15, thereby, not having organic groups present therein or proton conducting properties. In response, the examiner firstly asserts that applicant's claimed invention are entirely silent about the process-of-making the specific active layer so as to fairly contend that at least claim 17 circumscribes "a product-by-process" limitation. In this event, applicant's arguments concerning this issue are completely irrelevant, inaccurate and non-commensurate in scope with the present claim language. Also, the examiner secondly asserts that

assuming for argument purposes that such is the case (*i.e. that applicant's claimed invention includes a product-process limitation, a point clearly not conceded by the examiner*), there is still no objective evidence to show a difference in terms of structure or composition between the active layer at hand and the disclosed active layers; and/or unexpected results to rebut the prima-facie case of anticipation as it would apply to inventions incorporating a product-by-process clause (*See 2113 Product-by-Process Claims*).

Accordingly, the examiner also asserts that it is not enough that applicant's representative personally believes that the prior art lacks such specific organic groups or proton conducting properties. That is to say, the arguments of counsel cannot take the place of evidence in the record. An assertion of what seems to follow from common experience is just attorney argument and not the kind of factual evidence that is required to rebut a prima facie case of inherent anticipation/obviousness (*See MPEP 716.01 and 2145: Consideration of Applicant's Rebuttal Arguments*).

4. (new response) With respect to the new matter objection and the 35 USC 112 rejections, the examiner clearly explained his position in the office action dated 03/13/06, items 2-5. As a clarifying matter, the examiner in no way is disputing the that the presence of specific "*active layer comprising the carbon support that comprises at least one modified carbon product*" represents new matter by itself, what the examiner is contending herein is whether there is adequate support to unquestionably conclude that because the specification as filed does specifically disclose that "*the electrode, the counter-electrode or the electrolyte membrane comprises at least one modified carbon product*", it also means that other fuel cell components or the fuel cell as a whole, as now claimed, can also include the specific active layer. That is

certainly unclear and definitely not supported. Furthermore, the examiner still insists on the point that such specific active layer on the electrode, the counter electrode or the electrolyte membrane per se is critical or essential to the practice of the invention. In other words, having the specific active layer specifically present in/on any of the electrodes or the electrolyte membrane is actually the inventive concept of applicant; whereas, having the specific active layer in the fuel cell per se (including any component other than any of the electrodes or the electrolyte membrane) is neither the inventive concept at hand nor fully supported by the specification as filed. Keep in mind that this is very important for infringement purposes because it is not the same to say that the invention at hand does include the specific active layer in/on the electrodes or the electrolyte membrane, than saying that any fuel cell component does include the specific active layer. Therefore, the former does not raise new matter issue, however, the latter lacks adequate written description in the original disclosure.

5. *(new response)* With respect to applicant's arguments stating that "no double patenting rejection should be made" because "the application and patent are not commonly owned and do not have a common inventor", the fact that applicant now has admitted on record that "US Patent 6881511 B1 is assigned to Cabot Corporation and Edison Thermoelettrica, SpA, whereas the present application is assigned only to Cabot Corporation" provides sufficient lead to believe that both invention (i.e. the inventions of present application and patent'511) are both at least "partially owned" by Cabot Corporation. That is, the invention of the present application is "fully" owned by Cabot Corporation while the invention of patent'511 is "partially" owned by Cabot Corporation as well. That being said and contrary to applicant's position, the examiner deems that the present application and patent'511 are commonly owned by Cabot Corporation

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irrespective of the degree or extent of ownership. As such, as per **Flow Chart IIB: Conflicting Claims Between an Application and a Patent, Different Inventions (Not patentably Distinct)** in **MPEP 804 Definition of Double Patenting**, this double patenting scenario can be categorized as “Currently Commonly Owned- Different Inventive Entities”, and therefore, specific actions under this categorization are applicable thereto; being an obviousness double patenting rejection the action to take assuming that the both inventions were commonly owned at time of applicant’s invention, otherwise, additional actions can also be taken.

6. (new response) The information disclosure statement filed 06/13/06 fails to comply with 37 CFR 1.97(d) because it lacks a statement as specified in 37 CFR 1.97(e). It has been placed in the application file, but the information referred to therein has not been considered. **MPEP**

**609 Information Disclosure Statement** establishes the following:

(d) *An information disclosure statement shall be considered by the Office if filed by the applicant after the period specified in paragraph (c) {wherein (c) refers to an action that otherwise closes prosecution in the application} of this section, provided that the information disclosure statement is filed on or before payment of the issue fee and is accompanied by:*

(1) *The statement specified in paragraph (e) of this section; and*

(2) *The fee set forth in § 1.17(p).*

(e) *A statement under this section must state either:*

(1) *That each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement; or*

(2) *That no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing the certification after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in §1.56(c) more than three months prior to the filing of the information disclosure statement.*

In this case, applicant’s *Second Supplemental Information Disclosure Statement Pursuant to 37 CFR 1.97(c)* filed on 06/13/06 only states the following: “*The undersigned hereby certifies that each item of information contained in the information disclosure statement was first cited in*

*a communication from the US Patent and Trademark Office in a counterpart application not more than three months prior to the filing of the information disclosure statement*". As seen above, applicant's statement is actually a modification of the proper statement under (e)(1) above. Therefore, applicant's statement is in improper form at this period (*after closing of prosecution*) and does not comply with the specific requirement as set forth in paragraph (e).

7. The gist of applicant's arguments is premised on the assertion that the prior art of record does not disclose "*A modified carbon product having attached at least one organic group that is proton-conducting*". However, this assertion is respectfully disagreed with. For instance, both Yu et al and Tosco et al disclose the preference of proton conduction properties in their gas diffusion-catalytic support bodies as presented supra. Additionally, since the specifically recited carbon modified material i.e. ("*the carbon support that comprises at least one modified carbon product, wherein said modified carbon product comprises a carbon product having attached at least one organic group that is proton conducting*") covers a very large number of applicable materials which can be used therefor, it is also contended that a layer comprising any combination of carbon modified materials would produce a layer exhibiting the specific proton conducting property. Moreover, products of identical chemical composition (*i.e. carbon modified materials comprising a carbon product having attached at least one organic group*) can not have mutually exclusive properties, and thus, the claimed property (*i.e. proton conducting*), is necessarily present in the prior art material.

8. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (*i.e., "As clarified by the amendment to claim 1, an active layer is present in the gas diffusion electrode or counter-*

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*electrode or both, and the layer has a film thickness of 10 microns or less” [See the 02/16/06 amendment at page 8, 1<sup>st</sup> full paragraph])* are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). No where in independent claim 17 the examiner can find the foregoing limitations (*i.e. a) the active layer being part of the gas diffusion electrode or counter-electrode or both; and b) the specific thickness of the layer*). Thus, applicant’s arguments are not commensurate in scope with the presently claimed invention of independent claim 17.


9. In response to applicant’s argument that Swathirajan et al’871 only indicates an oxidized surface and does not indicate an attached organic group, it is contended that the prior art reference discloses the use of carbon groups containing carboxylic groups on the carbon surface (*the organic group*) (Swathirajan et al’871-COL 12, lines 60-65). Swathirajan et al further disclose that is known to attach or bond the organic groups thereto (COL 12, lines 60-65). Therefore, Swathirajan et al’871 readily envision attaching or bonding an organic group such as a carboxylic group to the surface of the carbon material.

10. With respect to applicant’s arguments regarding the “*or less” phrase*” (*i.e. “a thickness of 10 microns or less”*), the examiner herein maintains his position that such a phrase does not intend to recite a positive limitation per se, and does include 0 as a lower limit. Thus, the foregoing limitation also reads on “a layer free” or “a thickness of 0 micron”. (See *MPEP 2173.05(c) Numeral Ranges & Amounts Limitations, II. Open-Ended Numerical Ranges*). If applicant intends to recite a positive magnitude or thickness of the layer, applicant is required to positively include or recite a lower limit greater than or no less than 0 for such purposes. The



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language of claim 1, as it stands right now, can be fairly construed as an unintentional attempt to recite a layer-free or a layer having a thickness of 0 micron. *Simply put and in the context of the claimed invention, a fuel cell just comprising a modified carbon material regardless of its specific form or structure therein.* Thus, since applicant contends that claim 1 recites layer thicknesses greater than 0 microns, there should be no concerns about amending claim 1 to recite so; otherwise, for purposes of clarity and infringement, the examiner avers that claim 1 encompasses 0 as a lower limit for thickness dimension, and hence, no active layer is required in the fuel cell, that is to say, the specific carbon modified material can be present in any form other than in a layer (e.g. as a powder material; a particulate matter, or a dissolved substance or the like). (***Emphasis added***→) The examiner wants to clarify that interpreting the claim language, as set forth above, in no way means that the examiner is overlooking or ignoring the positive presence of the specific carbon modified-material, but it permits the examiner not to give patentable weight to the apparent formation of a further structure such as a dimensioned layer containing thereof. Otherwise stated, the recitation of claim 17 and combination with claim 1 still allows the interpretation of having a carbon-modified material in a free state or freely-distributed in the fuel cell.



RAYMOND ALEJANDRO  
PRIMARY EXAMINER